

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.111, and in light of the remarks which follow, are respectfully requested.

Claim 1 have been rewritten as amended claim 1 and new claim 10. Claims 3-5 have been amended in view of the amendments to claim 1. New claim 9 recites subject matter deleted from claim 1. New claims 11-14 correspond to claims 3-5 and 9, respectively, and depend from claim 10. Claims 2 and 6-8 were previously canceled.

Upon entry of the Amendment, claims 1, 3-5 and 9-14 will be all the claims pending in the application.

I. Response to Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 1 and 3-5 were rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth in paragraph 4 of the Office Action.

Applicants respectfully submit that the present claims are not indefinite for the following reasons.

As recited in the claims, (b) is optional. In addition, (d) and (e) are alternatives. That is, when (b) is involved, (d) is required. On the other hand, when (b) is not involved, (e) is required. (f) and (g) are required to obtain the final product. Furthermore, (c) is required whether or not (b) is involved. In this regard, formula (III e) as defined in (c) encompasses both formula (III d) resulted in (a) and formula (III e) defined in (b) as explained below.

Specifically, in formula (III e) defined in (c), (i) Y₁ represents hydroxy or protected hydroxy, Y₂ is hydrogen, Y₃ is hydroxy or protected hydroxy, and Y₁ and Y₃ form a syn-diol configuration; or (ii) Y₁ and Y₃ together represent -O-Alk-O- and Alk being C₁-C₇alkylidene,

Y_2 is hydrogen, and Y_1 and Y_3 form a syn-diol configuration; or (iii) Y_1 and Y_2 together represent the oxo group and Y_3 represents protected hydroxy. When Y_1 , Y_2 and Y_3 have the definitions of above (i) or (ii), formula (III e) defined in (c) is the same as formula (III e) defined in (b). Furthermore, when Y_1 , Y_2 and Y_3 have the definitions of above (iii), formula (III e) defined in (c) is the same as formula (III d) resulted in (a).

Nonetheless, for further clarity, Applicants have rewritten claim 1 to split into two sets of claims, one of which does not recite (b) and the other recites (b). Moreover, claim 1 has been amended to delete the phrase "if desired."

It was also asserted that "words like 'reacting' and 'converting' lack essential steps needed to make the final products" (page 2, last two lines of the Office Action).

Applicants respectfully disagree. The "reacting" and "converting" are commonly used and well known in the art to indicate chemical transformations, as evidenced by the references cited on the Form PTO-892 attached to the Office Action. Exemplary claims in these references, which contain such language, are shown below:

(a) U.S. Patent. No. 6,909,003

Claim 8: "converting a resulting free acid ... into ..."

Claim 9: "a process comprising reacting a compound ..."

(b) U.S. Patent. No. 6,835,838

Claim 9: "... is prepared by reacting ... with ..."

Claims 22 and 24: "converting ... to ..."

(c) U.S. Patent. No. 6,528,661

Claim 1: "converting ... to ..."

Claims 5 and 6: "... is converted into ..."

(d) U.S. Patent. No. 7,064,209

Claim 1: "a process ... comprising reacting ... with ..."

(e) U.S. Patent. No. 6,965,031

Claim 1: "... by reacting ... with ..."

Claims 7 and 9-13: "... is reacted with"

In view of the above, the Examiner is respectfully requested to reconsider and withdraw the § 112, second paragraph, rejection.

II. Conclusion


From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (202) 452-7932 at his earliest convenience.

Respectfully submitted,

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By: _____



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